

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 3, 4, 6-11, 13, 14, 16-21, 23, 24, and 26-39 are currently pending. Claims 1, 9, 11, 19, 21, 29, and 31-33 have been amended; and Claims 34-39 have been added by the present amendment. The changes and additions to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1, 3, 6-8, 11, 13, 16-18, 21, 23, 26-28, and 31-33 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 5,887,216 to Motoyama (hereinafter “the ‘216 patent”) in view of U.S. Patent No. 6,584,454 to Hummel, Jr. et al. (hereinafter “the ‘454 patent”); Claims 4, 14, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘216 and ‘454 patents, further in view of U.S. Patent No. 5,864,783 to Struck et al. (hereinafter “the ‘783 patent”); and Claims 9, 10, 19, 20, 29, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘216 and ‘454 patents, further in view of U.S. Patent No. 6,167,358 to Othmer et al. (hereinafter “the ‘358 patent”).

Amended Claim 1 is directed to a system for tracking at least one of a device state and a device event of a remotely monitored device, comprising: (1) a receiver configured to receive the at least one of the device state and the device event of the remotely monitored device; (2) a digital storage system configured to maintain a history of the at least one of the device state and the device event of the remotely monitored device, and a service history of the remotely monitored device; (3) an analyzer configured to analyze the service history and the at least one of the device state and the device event of the remotely monitored device to determine a service request to be performed on the remotely monitor device; and (4) a service depot comprising a computer configured to receive the service request from the analyzer over

a Wide Area Network, to analyze the service request, and to contact a user of the remotely monitored device regarding the service request. Further, Claim 1 has been amended to clarify that the service depot is configured to provide preventive and reparative maintenance to the remotely monitored device. The changes to Claim 1 are supported by the originally filed specification and do not add new matter.<sup>1</sup>

Regarding the rejection of Claim 1 under 35 U.S.C. § 103, the Office Action asserts that the '216 patent discloses everything in Claim 1 with the exception of "the service request being sent to a service depot, where the service request is analyzed, and then sent to the remotely located device,"<sup>2</sup> and relies on the '454 patent to remedy those deficiencies.

Applicants respectfully submit that the rejection of Claim 1 (and dependent Claims 3, 6-8, and 31) is rendered moot by the present amendment to Claim 1.

The '216 patent is directed to a method and system for determining whether problems exist in a business office device by analyzing user settings of the business office device. However, as admitted in the Office Action, the '216 patent fails to disclose a service depot comprising a computer configured to receive a service request from an analyzer over a Wide Area Network, and to analyze the service request, as recited in Claim 1. Moreover, Applicants respectfully submit that the '216 patent fails to disclose a service depot comprising a computer configured to contact a user of the remotely monitored device regarding the service request, wherein the service depot is configured to provide preventive and reparative maintenance to the remotely monitored device, as recited in amended Claim 1.

The '454 patent is directed to a method and a system for delivery of protected software applications to remote systems from a central service facility, wherein the delivery is managed based on the community membership of a remote system user. However, Applicants respectfully submit that the '454 patent fails to disclose a service depot

---

<sup>1</sup> See, e.g., paragraph 11 of the specification.

<sup>2</sup> See page 3 of the Office Action dated November 9, 2004.

comprising a computer configured to contact the user of the remotely monitored device regarding a service request, wherein the service depot is configured to provide preventive and reparative maintenance to the remotely monitored device, as recited in amended Claim 1.

Thus, no matter how the teachings of the '216 and '454 patents are combined, the combination does not teach or suggest a service depot comprising a computer configured to contact a user of remotely monitored device regarding a service request, wherein the service depot is configured to provide preventive and reparative maintenance to the remotely monitored device, as recited in Claim 1. Accordingly, Applicants respectfully submit that amended Claim 1 (and dependent Claims 3, 6-8, and 31) patentably define over any proper combination of the '216 and '454 patents.

Independent Claims 11 and 21 recite limitations analogous to the limitations recited in amended Claim 1. Moreover, Claims 11 and 21 have been amended in a manner analogous to the amendment to Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejections of Claims 11 and 21 (and all similarly rejected dependent claims) are rendered moot by the present amendment to Claims 11 and 21.

Regarding the rejection of dependent Claims 4, 9, 10, 14, 19, 20, 24, 29, and 30 under 35 U.S.C. § 103, Applicants respectfully submit that the '783 and '358 patents fail to remedy the deficiencies of the '216 and '454 patents, as discussed above. Accordingly, Applicants respectfully submit that the rejections of dependent Claims 4, 9, 10, 14, 19, 20, 24, 29, and 30 are rendered moot by the present amendment to the independent claims.

The present amendment also sets forth new dependent Claims 34-39 for examination on the merits. New Claim 34, which depends from Claim 1, recites that the computer is configured to contact the user of the remotely monitored device through the WAN. Further, new Claim 35, which depends from Claim 1, recites that the computer is configured to

contact the user of the remotely monitored device by telephone or through an electronic mail message. New dependent Claims 36-39 recite similar limitations, but dependent from either Claim 11 or Claim 21. New Claims 34-39 are supported by the originally filed specification and do not add new matter.<sup>3</sup> Further, based on the asserted allowability of independent Claims 1, 11, and 21, Applicants respectfully submit that new Claims 34-39 patentably define over any proper combination of the '216, '454, '783, and '358 patents.

Thus, it is respectfully submitted that independent Claims 1, 11, and 21 (and all associated dependent claims) patentably define over any proper combination of the '216, '454, '783, and '358 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



James. J. Kulbaski  
Attorney of Record  
Registration No. 34,648  
Kurt M. Berger, Ph.D.  
Registration No. 51,461

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)  
JJ/KMB:aif

I:\ATTY\KMB\5244\5244-0130\52440130-AM1.DOC

<sup>3</sup> See, e.g., paragraph 28 of the specification.